



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/894,476

06/28/2001

Andrew Comas

72167.000564

5938

21967

7590

07/21/2011

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
2200 Pennsylvania Avenue, N.W.
WASHINGTON, DC 20037

EXAMINER

GRAHAM, CLEMENT B

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

07/21/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/894,476	Applicant(s) COMAS ET AL.	
	Examiner CLEMENT GRAHAM	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/15/10.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-12 remained pending in this Application.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-12, are rejected under 35 U.S.C. 102(e) as being anticipated by Bowman-Amuah US Patent 7, 139, 999.

As per claim 1, Bowman-Amuah discloses a computer implemented method for structured development of migration options in a legacy transactional enterprise, the method comprising, identifying components of the legacy enterprise, developing risk factors for the components of the legacy enterprise; identifying unmet opportunities, developing risk factors for the unmet opportunities; identifying potential components for the legacy enterprise (see column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40) developing risk factors for the potential components of the legacy enterprise; with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components and providing by a computer migration options and developing by a computer the migration options (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67).

As per claim 2, Bowman-Amuah discloses wherein the components of the legacy enterprise

Art Unit: 3691

are selected from the group consisting of hardware or software (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99- 102 lines 1-67).

As per claim 3, Bowman-Amuah discloses wherein the unmet opportunities are selected from the group consisting of new hardware, new software or new business methods (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 4, Bowman-Amuah discloses wherein the potential components for the legacy enterprise are selected from the group consisting of hardware or software (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column-26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 5, Bowman-Amuah discloses wherein the potential components for the legacy enterprise include conceptual models of undeveloped capabilities (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 6, Bowman-Amuah discloses wherein the risk factors include multiple variables (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 3.5 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and

column 99-102 lines 1-67).

As per claim 7, Bowman-Amuah discloses wherein the risk factors are selected from the group consisting of cost or schedule (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 8, Bowman-Amuah discloses wherein the migration options with associated risk factors are selected from the group consisting of existing components or conceptual models of undeveloped capabilities (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 9, Bowman-Amuah discloses wherein the associated risks of the migration options are derived from the risk factors for the components of the legacy enterprise, the risk factors for the unmet opportunities, and the risk factors for the potential components of the legacy enterprise (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67).

As per claim 10, Bowman-Amuah discloses a programmed computer processor configured to executable software code transmitted as an information signal, the code for structured development of migration options in a legacy transactional enterprise, the code comprising: code to capture identity of components of the legacy enterprise; code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines

Art Unit: 3691

41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67) code to capture risk factors for the unmet opportunities, code to capture identity of potential components for the legacy enterprise (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67) code to capture risk factors for the potential components of the legacy enterprise and code with associated risks using at least the risk factors for the components the risk factors for the unmet opportunities and the risk factors for the potential providing by a computer migration options and developing by a computer the migration options (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67 and column 130 lines 61-67 and column 131 lines 1-40).

As per claim 11, Bowman-Amuah discloses a non-transitory computer-readable medium having computer executable software code stored thereon, the code for structured development of migration options in a legacy transactional enterprise, the code comprising: code to capture identity of components of the legacy enterprise (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67) code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet code to capture risk factors for the unmet opportunities, code to capture identity of potential components for the legacy enterprise (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines

32-65 and column 138 lines 36-65 and column 99-102 lines 1-67) code to capture risk factors for the potential components of the legacy enterprise, and code with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components providing by a computer migration options and developing by a computer the migration options (see column 21 lines 33- 40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1- 67 and column 130 lines 61-67 and column 131 lines 1-40).

As per claim 12, Bowman-Amuah discloses a programmed computer for structured development of migration options in a legacy transactional enterprise, comprising: a memory having at least one region for storing computer executable program code; and a processor for executing the program code stored in the memory; wherein the program code comprises code to capture identity of components of the legacy enterprise code to capture risk factors for the components of the legacy enterprise; code to capture identity of unmet opportunities, code to capture risk factors for the unmet opportunities (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67) code to capture identity of potential components for the legacy enterprise, code to capture risk factors for the potential components of the legacy enterprise, and code with associated risks using at least the risk factors for the components, the risk factors for the unmet opportunities and the risk factors for the potential components providing by a computer migration options and developing by a computer the migration options (see column 21 lines 33-40 and column 26 lines 46-65 and column 27 lines 1-10 and column 42 lines 14-42 and column 72 lines 44-65 and column 73 lines 1-11 and column 107 lines 1-40 and column 27 lines 66-67 and column 28 lines 1-41 and column 44 lines 41-67 and column 45 lines 1-16 and column 35 lines 20-41 and column 26 lines 32-65 and column 138 lines 36-65 and column 99-102 lines 1-67 and column

130 lines 61-67 and column 131lines 1-40).

Conclusion

Response to Arguments

4. Applicant's arguments filed 12/15/10 have been fully considered but they are moot in view of new grounds of rejections.

5. In response to Applicant's arguments that Bowman-Amuah fails to teach or suggest" development of migration options in a legacy transaction enterprise, and "identifying potential components for the legacy enterprise." and identifying unmet opportunities and developing risk factors, for the components and identifying unmet opportunities" the Examiner disagrees because Applicant's claimed limitations were addressed as stated.

Bowman-Amuah discloses an integrated development architecture framework in a legacy system, that consist of software and hardware migration, and upgrades to application software and systems software which would have been inherently consistent with migration options because a feasibility study would have to be done prior to the migration in order to determine which software or hardware options would be chosen that is most economical and feasible or compatible with the legacy system and identifying potential components, developing risk factors, for the components and identifying unmet opportunities would have had to be done as part of the feasibility study whereby upon migration all the required components would be in place. Therefore it is inherent that Applicants claimed limitations of software or hardware migration were addressed with the teachings of Bowman-Amuah.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CLEMENT GRAHAM whose telephone number is (571)272-6795. The examiner can normally be reached on 7am to 5pm.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B. Graham whose telephone number is 571-272-6795. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CG

Art Unit 3691

May 19, 2001

/HANI M KAZIMI/

Primary Examiner, Art Unit 3691